The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDOLPH S. KOHLMAN, ALLAN W. SMITH, THOMAS E. GODFREY, CHARLES E. WILLBANKS, and ALLEN M. SMITH

Appeal 2007-1373
Application 10/651,687
Technology Center 1700

Decided: August 30, 2007

Before CHUNG K. PAK, THOMAS A. WALTZ, and CATHERINE Q. TIMM, *Administrative Patent Judges.*

WALTZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 73 through 83, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to a textile composite for constructing a bag used in non-immersion dry cleaning, where the composite comprises a textile substrate and a polymer facing with specified Kawabata stiffness values and surface friction values for the walls of the bag (Br. 2). Independent claim 73 is illustrative of the invention and a copy of this claim is reproduced below:

73. A textile composite for constructing an inherently two-dimensional containment bag that, when constructed, has an interior surface and an exterior surface, said bag being suitable for use in a non-immersion dry cleaning process, wherein said composite is comprised of a textile substrate and a polymer facing, said composite having a minimum average Kawabata stiffness value of at least about 0.6 gms (force) cm^2/cm. and a maximum average Kawabata stiffness value of about 3.0 gms (force) cm^2/cm., and wherein the surface carrying said polymer facing has a maximum average Kawabata surface friction value of about 0.35.

The Examiner has relied on the following prior art references as evidence of unpatentability:

Feitlowitz	US 3,809,573	May 07, 1974
Drelich	US 3,889,024	Jun. 10, 1975
Cross	US 5,534,298	Jul. 09, 1996
Scholz	US 6,159,877	Dec. 12, 2000

ISSUES ON APPEAL

Claims 73-80 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Feitlowitz (Answer 3).

Claims 73-79 and 81 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cross (Answer 4).

Claims 81 and 82 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Feitlowitz in view of Scholz (*id.*).

Claim 83 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Feitlowitz in view of Drelich (Answer 5).

Appellants contend that Feitlowitz is limited to the impregnation of a set of stiffening compositions to 100% polyester fabrics, and it is open to speculation by the Examiner whether these fabrics might have Kawabata stiffness values within the claimed ranges, much less the specified Kawabata surface friction values (Br. 6).

Appellants contend that Cross is directed to the application of an aerated or foamed latex compound to a fabric in a manner that does not result in the penetration of the compound to the opposite side of the fabric (Br. 8). Appellants further contend that Cross uses dissimilar materials and processes to those claimed, and thus there is no reason to presume any inherent characteristics (*id.*).

Appellants contend that Scholz is not directed to the issue of surface friction, but is drawn to fabrics intended for use as orthopedic casting materials having a stiffness exceeding those claimed (Br. 10). With regard to Drelich, Appellants merely contend that this reference does not overcome the shortcomings of Feitlowitz (Br. 12).

Although the Examiner admits that neither Feitlowitz nor Cross discloses the Kawabata stiffness values or surface friction values as claimed by Appellants, the Examiner contends that it is reasonable to presume that these properties are inherent in the reference composites since both references teach the use of similar starting materials and similar production

steps to those of Appellants (Answer 3-4 and 6-7). Alternatively, the Examiner contends that the claimed stiffness values would have been obvious in view of the teachings in both references of adjusting the stiffness level (*id.*).

The Examiner contends that Scholz teaches that desirable elastic stretch yarns for a backing material that is impregnated with a resin should have a low denier that is no greater than about 500 denier (Answer 4).

Accordingly, the issues presented from the record in this appeal are as follows: (1) although neither Cross nor Feitlowitz disclose any Kawabata values for stiffness or surface friction, has the Examiner established a reasonable basis that these values would have been inherent or at least obvious to one of ordinary skill in this art?; and (2) has the Examiner identified a proper reason for the combination of Scholz with Feitlowitz?

We determine that the Examiner has established a prima facie case of anticipation and obviousness in view of Cross or Feitlowitz, which prima facie case has not been adequately rebutted by Appellants' arguments. We further determine that the Examiner has established a prima facie case of obviousness in view of Feitlowitz, Drelich, and Scholz, which prima facie case has not been adequately rebutted by Appellants' arguments. Therefore, we AFFIRM all grounds of rejection presented in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

We determine the following factual findings from the record in this appeal:

(1) Feitlowitz discloses an improved product produced by impregnation of a polyester fabric with a stiffening agent mixture to overcome the problem of lack of retention of initial stiffness, where the stiffness of the material can be controlled to find a balance between proper stiffness and proper hand (col. 1, ll. 54-66; col. 2, ll. 42-48 and 55-60);

(2) Cross discloses a woven synthetic fabric coated with a latex compound to form a stiff fabric, where the latex compound is applied so that the compound passes into the interstices of the fabric but remains substantially clear of the face side (Abstract; col. 2, ll. 50-58; and col. 3, ll. 20-38);

(3) Cross desires sufficient stiffness in the fabric such that it is self-supporting, and only marginally aerates or foams the latex compound to achieve the desired stiffening characteristics (col. 1, ll. 25-26, 37-39; col. 2, ll. 12 and 23; col. 2, l. 65-col. 3, l. 1; and col. 4, ll. 50-56);

(4) Cross teaches that a predetermined stiffness is desired, as well as a test for measuring stiffness, while exemplifying a fabric backing of polyester yarn of 150 denier (col. 3, ll. 51-52, 60-65; col. 5, ll. 7-11, 27-32; and col. 6, ll. 20-27);

(5) Drelich teaches that "common textile-length fibers" used as a conventional base starting material vary in length from approximately ½ inch to about 2 ½ inches (col. 2, ll. 36-40); and

(6) Scholz teaches a backing material with resin impregnation desirably is warp knit yarn of low denier, preferably no greater

than about 500 denier (col. 2, ll. 45-48; col. 7, ll. 57-58; and col. 8, ll. 31-35).

"Appellants have chosen to describe their invention in terms of certain physical characteristics of the roughened substrate surface." Merely choosing to describe their invention in terms of variables not present in the prior art does not render the claimed subject matter patentable. *In re Skoner,* 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975). "Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. [Citation omitted]. Whether the rejection is based on 'inherency' under 35 U.S.C. § 102, on 'prima facie obviousness' under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products." *In re Best,* 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977); *see also In re Spada,* 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990). The Examiner's analysis supporting obviousness should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the art to combine the elements" in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.,* 127 S. Ct. 1727, 1731, 82 USPQ2d 1385, 1389 (2007). Discovery of the optimum value of a result-effective variable is ordinarily within the skill in the art. *See In re Aller,* 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); *and In re Boesch,* 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

Applying the preceding legal principles to the factual findings in the record of this appeal, we determine that the Examiner has properly established a prima facie case of anticipation and obviousness, which prima facie case has not been adequately rebutted by Appellants' arguments. As shown by factual findings (1) through (3) listed above, and not contested by Appellants, we determine that Feitlowitz and Cross disclose a textile composite comprising a textile substrate and a polymer facing. As established by the Examiner (Answer 6-7), we determine that Feitlowitz and Cross disclose textile substrates and polymers as well as methods of impregnating the polymers into the textile substrate that are the same or similar to those disclosed by Appellants (e.g., *see* factual findings (1), (2), and (4) listed above as compared to claim 79 on appeal). As admitted by the Examiner, the claimed values of Kawabata stiffness and surface friction are not disclosed by Feitlowitz or Cross (Answer 3-4). However, we determine that the Examiner has established that the products of the prior art reasonably appear to be the same or substantially similar to those claimed. Thus the burden has been shifted to Appellants to prove that the claimed products are not the same or similar to the prior art products. *See In re Best, supra; In re Spada, supra.* We determine that Appellants have not met this burden. Merely reciting variables in the claims that are not found in the prior art does not render a product patentable. *See In re Skoner, supra.* Additionally, as shown by factual findings (1), (3), and (4) listed above, we determine that Feitlowitz and Cross teach the control and testing of stiffness to achieve the desired result, and thus the determination of optimum or desired values would have been well within the ordinary skill in the art.

Appellants do not contest the Examiner's findings and combination of Drelich with Feitlowitz other than to repeat their arguments against the primary reference (Br. 12). Accordingly, we adopt the findings and conclusion of law as stated in the Answer (*see* factual finding (5) listed above). With regard to Appellants' arguments against Scholz (Br. 10), we note that Scholz was merely applied to show a similar textile fabric impregnated with a resin to achieve a controlled stiffness, with a teaching that desired yarns have a low denier of no greater than 500 denier (*see* factual finding (6) listed above). We also note that Cross exemplifies a product the same as or similar to the claimed product where the backing material is made from a textile with a denier of 150 (*see* factual finding (4) listed above). Accordingly, we determine that selection of the appropriate denier for the textile backing or substrate of the Feitlowitz product would have been suggested to one of ordinary skill in the art from the teachings of Scholz.

For the foregoing reasons and the reasons stated in the Answer, we affirm all grounds of rejection presented in this appeal. The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

PL/LT initials:

SLD/LS

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